

REMARKS

Applicants have amended claims 1, 8-9, and 14-18, and canceled claims 1-8, 10-13, and 16. with respect to the present patent application. Applicants are not conceding in the present patent application that these claims are not patentable over the art cited by the Examiner, as the claim amendments and cancellations are only for facilitating expeditious prosecution of the patent application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

This preliminary amendment addresses the office action mailed October 12, 2007.

The newly added/amended limitations in claim 9 of “receiving commands from a telephone caller; responsive to said received commands, determining that the voice prompt is needed; responsive to said determining that voice prompt is needed, providing a variable identified with a function of the voice prompt ” is supported in the specification, page 6, line 18 - page 7, line 2.

The Examiner rejected claims 9 and 18-21 under 35 U.S.C. § 102(b) as allegedly being anticipated by Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

The Examiner rejected claims 14, 15, 17 and 22-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

Applicant respectfully traverses the § 102 and § 103 rejections with the following arguments.

35 U.S.C. § 102(b)

The Examiner rejected claims 9 and 18-21 under 35 U.S.C. § 102(b) as allegedly being anticipated by Osder et al. (US Patent 5,493,606) hereinafter referred to as "Osder."

Since claim 21 has been canceled, the rejection of claim 21 under 35 U.S.C. § 102(b) is moot.

Applicants respectfully contend that Osder does not anticipate claim 9, because Osder does not teach each and every feature of claim 9.

As a first example of why Osder does not anticipate claim 9, Osder does not teach the feature: "receiving commands from a telephone caller; responsive to said received commands, determining that the voice prompt is needed". Although Osder reaches commands from software, Osder does not teach commands from a telephone caller. Although Osder teaches determining that the voice prompt is needed, Osder does not teach determining that the voice prompt is needed in response to commands received from the telephone caller.

As a second example of why Osder does not anticipate claim 9, Osder does not teach the feature:

"identifying a first database record that includes a digitally encoded voice prompt consisting of a first bit pattern that consists of a first sequence of bits, wherein the bits of the first sequence of bits are stored contiguously in the identified first database record, and wherein said identifying the first database record is implemented through use of the first value which selects the first database record and specifies the first bit pattern;
reading the identified first database record;

passing the first bit pattern from the first database record that had been read to an audio apparatus;

performing, by the audio apparatus, a digital-to-analog conversion of the first bit pattern that had been passed to the audio apparatus; and

speaking, by the audio apparatus, a first message to the telephone caller, said first message consisting of the digital-to-analog converted first bit pattern.”

As indicated in the decision of the Board of Appeals and Interferences (page 4, line 22 - page 5, line 3) on February 21, 2007, Osder’s voice prompt that is spoken at runtime is assembled by inserting dynamic data (e.g., from Table 5 of Osder) into a template (e.g., from Table 3 of Osder) having static elements and missing portions, wherein the dynamic elements are inserted into the missing portions of the template to generate the final assembled voice prompt. See also, Osder, col. 1, lines 48-57 which recites: “A prompt is composed of and defined by a sequence of static and dynamic elements. A static element denotes a fixed phrase, whereas a dynamic element provides a location in the prompt for variable data to be provided by the Network Application at run time. For example, in the prompt "you have <number> new messages", the phrases "you have" and "new messages" are static elements whereas <number> is a dynamic element to be provided by the Network Application in accordance with the conditions at run time.”

Osder does not teach omission of the preceding “assembling step” of assembling the runtime voice prompt by inserting the dynamic data into the template having the static elements and the missing data. Therefore, by being required to perform said “assembling step”, it is logically impossible for Osder to teach that the content of the spoken message at runtime consists

of the digital-to-analog converted first bit pattern existing in the first database record, as recited in claim 9.

In other words, Osder's voice prompt that is spoken at runtime is generated by the "assembling step" from two distinct bit patterns located in different database records, namely first bit pattern consisting of a static element located in one portion of a database and a second bit pattern consisting of a dynamic element located in another portion of the database. The Examiner has acknowledged that the static and dynamic elements are stored in separate tables, namely Tables 3 and 5, respectively, and therefore do not collectively constitute a bit pattern that is stored in the first database record.

For example, using the Examiner's of "you have five new messages", Osder does not teach the step of "speaking, by the audio apparatus, a first message to the telephone caller, said first message consisting of the digital-to-analog converted first bit pattern". In this example, the message spoken to the telephone caller ("you have five new messages") is not the result of a digital-to-analog conversion of a first bit pattern such that the first bit pattern consists of a contiguous sequence of bits, wherein the bits of the first sequence of bits are stored contiguously in the first database record prior to the digital-to-analog conversion. The spoken message is the result of converting three distinct bit patterns ("you have", "five", and "new messages") which do not collectively constitute a sequence of bits stored contiguously in a first database record prior to the digital-to-analog conversion. Osder teaches that the bits of the bit pattern "you have" is stored contiguously. Osder teaches that the bits of the bit pattern "five" is stored contiguously. Osder teaches that the bits of the bit pattern "new messages" is stored contiguously. However, Osder does not teach that the bits of the bit pattern "you have five new messages" is stored

contiguously in a first database record prior to the digital-to-analog conversion, as required by claim 9.

Therefore, Osder does not teach the preceding feature of claim 9.

Based on the preceding arguments, Applicants respectfully maintain that Osder does not anticipate claim 9, and that claim 9 is in condition for allowance. Since claims 18-20 depend from claim 9, Applicants contend that claims 18-20 are likewise in condition for allowance.

In addition with respect to claim 19, Osder does not teach the feature: “ wherein said assigning the second value and said replacing the first value with the second value are performed by an interactive voice response (IVR) system administrator.”

The Examiner argues: “Osder further discloses: wherein said assigning the second value and said replacing the first value with the second value are performed by an interactive voice response (IVR) system administrator (i.e. col. 3 lines 64- col. 4 lines 1-5).”

In response, Applicants respectfully cite Osder, col. 4, lines 3-4: “The SPIN application is created or modified **by the user** utilizing interactive SPIN screens” (emphasis added). Applicants assert that a “user” is not a “system administrator”. Therefore, the Examiner’s argument is not persuasive.

Accordingly, Osder does not teach the preceding feature of claim 19.

In addition with respect to claim 20, Osder does not teach the feature: “wherein said replacing the first value with the second value by the IVR system administrator does not

comprises using special IVR programming skill to replace the first value with the second value”.

The Examiner argues: “Osder further discloses: wherein said replacing the first value with the second value by the IVR system administrator does not comprises using special IVR programming skill to replace the first value with the second value (i.e. col. 3 lines 64- col. 4 lines 1-5, 33-37).”

In response, Applicants respectfully contend that the preceding citations to Osder do not teach that the IVR system administrator does not use special IVR programming skill to replace the first value with the second value. Therefore, the Examiner’s argument is not persuasive.

Accordingly, Osder does not teach the preceding feature of claim 20.

35 U.S.C. § 103(a)

The Examiner rejected claims 14, 15, 17 and 22-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

Since claims 11-13 and 16 have been canceled, the rejection of claims 11-13 and 16 under 35 U.S.C. § 103(a) is moot.

Since claims 14-15 and 17 depend from claim 9, which Applicant has argued *supra* to be patentable under 35 U.S.C. §102(b) over Osder, Applicants maintain that claims 14-15 and 17 are likewise not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claims 14-15, the decision of the Board of Appeals and Interferences (page 7, line 24 - page 8, line 7) on February 21, 2007 recites: “We will sustain the Examiner's rejection of claims 3-8 and 11-16. At the outset, we note that specifying the various attributes of voice prompts in these claims merely describes the content of the data stored in the voice prompt database. Because this data content does not further limit the claimed invention either functionally or structurally, it essentially constitutes non-functional descriptive material. Such non-functional descriptive material, however, does not patentably distinguish over prior art that otherwise renders the claims unpatentable. *See In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004).”

In light of the preceding analysis by the Board of Appeals and Interferences, Applicants have restructured the language of claims 14-15 in a manner that the recited attributes of the voice prompts do not merely describe the content of the data stored in the voice prompt database, but actually recite the active method steps of speaking the first message. The language of claim 17 has been similarly restructured, as is the language of new claims 22-25. Thus, the language of

claims 14-15, 17, and 22-25 comprises functional material in the form of active method steps.

In addition with respect to claim 14, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record consists of music, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said music”.

The Examiner argues that “Per claim 14: ... Osder does not explicitly teach that the database includes a voice prompt that includes music. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include music voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 14. Since it is a legal requirement for the Examiner to show that preceding feature in claim 14 is taught or suggested in the prior art, which the Examiner has not done, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 14.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 14, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teaches how to include dynamic elements within a template of static elements only when the static and

dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are music. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 14.

Accordingly, claim 14 is not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claim 15, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record consists of an audio tone, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said audio tone”.

The Examiner argues that “Per claim 15: ... Osder does not explicitly teach that the database includes a voice prompt that includes an audio tone. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include audio tone of voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art ”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 15. Since it is a legal requirement for the Examiner to show that preceding feature in claim 15 is taught or suggested in the prior art, which the Examiner has not done, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 15.

Moreover, Applicants assert that it is not obvious to modify Osder to include the

preceding feature in claim 15, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teach how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are said audio tone. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 15.

Accordingly, claim 15 is not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claim 17, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record consists of a sequence of beeps, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said sequence of beeps”.

The Examiner argues that “Per claim 17: ... Osder does not explicitly teach that the digitally-encoded voice prompt consists of a sequence of beeps. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include various voice prompts such as including beeps as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that

discloses the preceding feature of claim 17. Since it is a legal requirement for the Examiner to show that preceding feature in claim 17 is taught or suggested in the prior art, which the Examiner has not done, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 17.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 17, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teach how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are a sequence of beeps. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 17.

Accordingly, claim 17 is not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claim 22, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record is spoken by a first speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a second speaker; herein said speaking the first message comprises speaking by the first speaker the first message consisting of the digital-to-analog converted first bit pattern; and wherein said speaking the second message comprises speaking by the second speaker the second message consisting of the digital-to-analog converted second bit pattern ”.

The Examiner argues that “Osder does not explicitly teach that the voice prompt pertaining to the first bit pattern in the first database record is spoken by a first speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a second speaker; wherein said speaking the first message comprises speaking by the first speaker the first message ... wherein said speaking the second message comprises speaking by the second speaker the second message consisting of the digital-to-analog converted second bit pattern. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different voice prompts spoken by different speakers as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different purposes.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 22. Since it is a legal requirement for the Examiner to show that preceding feature in claim 22 is taught or suggested in the prior art, which the Examiner has not done, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 22.

Accordingly, claim 22 is not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claim 23, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record is spoken by a male speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a female speaker; wherein said speaking

the first message comprises speaking by the male speaker the first message consisting of the digital-to-analog converted first bit pattern; and wherein said speaking the second message comprises speaking by the female speaker the second message consisting of the digital-to-analog converted second bit pattern”.

The Examiner argues that “Osder does not explicitly teach that the voice prompt pertaining to the first bit pattern in the first database record is spoken by a male speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a female speaker; wherein said speaking the first message comprises speaking by the male speaker the first message ... wherein said speaking the second message comprises speaking by the female speaker the second message consisting of the digital-to-analog converted second bit pattern. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different voice prompts spoken by male and female speakers as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 23. Since it is a legal requirement for the Examiner to show that preceding feature in claim 23 is taught or suggested in the prior art, which the Examiner has not done, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 23.

Accordingly, claim 23 is not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claim 24, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record has a first level of formality; wherein the voice prompt pertaining to the second bit pattern in the second database record has a second level of formality that differs from the first level of formality; wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern having the first level of formality; and wherein said speaking the second message comprises speaking the second message consisting of the digital-to-analog converted second bit pattern having the second level of formality”.

The Examiner argues that “Osder does not explicitly teach the voice prompt pertaining to the first bit pattern in the first database record has a first level of formality; wherein the voice prompt pertaining to the second bit pattern in the second database record has a second level of formality that differs from the first level of formality; wherein said speaking the first message ...second message consisting of the digital-to-analog converted second bit pattern having the second level of formality. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different level of formality of voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 24. Since it is a legal requirement for the Examiner to show that preceding feature in claim 24 is taught or suggested in the prior art, which the

Examiner has not done, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 24.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 24, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teach how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are different levels of formality. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 24.

Accordingly, claim 24 is not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claim 25, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record is spoken by a speaker in a first wording and conveys a meaning; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by the speaker in a second wording that differs from the first wording and conveys said meaning; wherein said speaking the first message comprises speaking by the speaker the first message consisting of the digital-to-analog converted first bit pattern in the first wording that conveys said meaning; and wherein said speaking the second message comprises speaking by the speaker the second message consisting of the digital-to-analog converted second bit pattern in the second wording that conveys said meaning”.

The Examiner argues that "Osder does not explicitly teach that the voice prompt pertaining... spoken by a speaker in a first wording and conveys a meaning...second wording that differs from the first wording and conveys said meaning... in the first wording that conveys said meaning... second bit pattern in the second wording that conveys said meaning. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include various voice prompts such as including a dialect as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences."

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 25. Since it is a legal requirement for the Examiner to show that preceding feature in claim 25 is taught or suggested in the prior art, which the Examiner has not done, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 25.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 25, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teaches how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are synthesized with different wording having the same meaning. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 25.

Accordingly, claim 25 is not unpatentable under 35 U.S.C. §103(a) over Osder.

CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457 (IBM).

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